

Atty. Docket No.: YOR920030442US1
Amdt. Dated June 12, 2008
Reply to Office action of March 14, 2008
Appl. No.: 10/725,735

PATENT

REMARKS

Claim Amendments

Claim 1 has been amended to include various features of the invention and claims 2-30 have been cancelled in order to expedite the present application to issuance. No new matter has been added by any of the foregoing amendments.

35 USC 101 Rejections

Claims 11-20 and claims 21-30 have been rejected as allegedly being directed to non-statutory subject matter. Applicant respectfully submits that the cancellation of claims 2-30 via the present amendment moots the rejections. Accordingly, reconsideration and withdrawal thereof is respectfully requested.

35 USC 103 Rejections

All of the claims have been rejected by various combinations of Minneman et al (US 6,243,740) in view of Williams (US-2002/0178442) in further view of Chisholm (US 5,400,248). Applicant respectfully submits that claim 1 as presently amended obviates the present rejection.

In order to make out a prima facie case of obviousness, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 180 USPQ 580 (CCPA 1970). The mere fact that references can be combined or modified does not render the resultant combination obvious, unless the prior art also suggest the desirability of the combination. *In re Mills*, 16 USPQ.2d 1430 (Fed. Cir. 1990). Further, a prior art reference must be considered in its entirety, i.e, as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Assoc. v. Garlock, Inc.*, 220 USPQ 303 (Fed. Cir. 1983).

The Supreme Court recent confirmed the obviousness inquiry. In the *KSR* case, the Supreme Court reiterated that the framework for applying the statutory

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language of 35 U.S.C. 103 was set out in *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1 (1966):

the scope and content of the prior art are to be determined; differences between the prior art and the claims in issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the subject matter sought to be patented.

KSR Int'l v. Teleflex Inc. (U.S. 2007). Although the Supreme Court held that the Teaching, Suggestion, Motivation (TSM) test is not the flexible test required by *Graham*, the Court noted that rejections based on obviousness grounds cannot be sustained by mere conclusory statements.

The Supreme Court stated that a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the art. Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way that the claimed new invention does. This is so because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what is already known. By asserting that a claimed combination is obvious to try, there should be demonstrated both (1) a design need or market pressure to solve a problem and (2) a finite number of identified, predictable solutions.

In the present application, the prior art relied upon in the Office Action does not suggest the combination as applied to the claims. In addressing the features of amended claim 1 that were in the now cancelled dependent claims, the Office Action

fails to make out a *prima facie* case of unpatentability. Specifically, for example, in rejecting claims 5, 15 and 25, the Office Action states that the limitation of “selectively excluding votes for a specific storyline branch comprises excluding the votes within a predetermined period of time before the specific storyline branch occurs” is met by claims 9, 11 and paragraph [0028] of Minneman.

Paragraph [0028] of Minneman (col. 8, ln 55-65) recites:

55 Alternative embodiments of the invention include direc-
tional voting, wherein custom antennas with directional
qualities will attend to signals coming from one set of
viewers whilst rejecting signals from another. This is made
somewhat more difficult by the wide range of frequencies
60 under consideration, but some measure of this effect is
certainly plausible. This will enable interaction modes that
might include eastbound/westbound voting or independent
interactions on each of the two screens. Phased arrays will
present even more interesting possibilities.

This portion of Minneman does not teach or suggest “excluding the votes within a predetermined period of time before the specific storyline branch occurs” as claimed. Minneman is not dealing with the issue of timing and controlling the fluidity of the storyline by rejecting votes that are not cast with sufficient time to be counted in determining the specific storyline branch to occur (and displaying that storyline in as much of a seamless fashion as possible). Further, neither claim 9 nor claim 11 address this specific issue (timely and seamless transition between storylines) and the claimed method of dealing with it (excluding late votes from being counted). To the extent Minneman discusses predetermined conditions and voting within some indicated time, the reference is referring to the use of “tokens for indicating a time for the communicating of the signals.” In other words, Minneman is providing a window of time in which to cast votes. After the window closes, votes cannot be cast. By stark constast, the present invention allows votes to be cast but excludes votes that are not cast within a predetermined period of time before the specific storyline branch occurs.

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In other words, Minneman is not "excluding votes" it is simply not allowing votes to be cast. Accordingly, for at least the foregoing reason, Minneman does not teach or suggest the invention as presently claimed. Moreover, the art of record does not overcome the deficiencies of Minneman in anticipating the present invention. Therefore, Applicant respectfully submits that claim 1 is patentable over the art of record and respectfully requests reconsideration and withdrawal of the present rejections.

CONCLUSION

In view of the above Amendments and Remarks, Applicant respectfully submits that the present application is in condition for allowance and early notification of the same is earnestly requested. Should the Examiner have and questions of comments or otherwise deem that prosecution of the present application may be advanced, the Examiner is invited to contact Applicant's representative at the number below.

Respectfully submitted,
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